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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,331	12/31/2003	Michael I. Silver	02496.401100	8130
5514	7590	06/21/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				FRANCIS, FAYE
ART UNIT		PAPER NUMBER		
3725				

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/748,331	SILVER ET AL.
	Examiner Faye Francis	Art Unit 3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
 - 4a) Of the above claim(s) 4 and 6-24 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 December 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/29/04, 5/12/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

group I, the species shown In Figs 1-3B;

group II, the species shown In Figs 4-6;

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims appear generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Justin J. Oliver on Tuesday June 7, 2005 a provisional election was made without traverse to prosecute the invention of group I, claims 1-3 and 5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 6-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

4. The lined through portion of the information disclosure statement filed 5/12/05 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

5. Claim 3 is objected to because of the following informalities: it appears that word --to-- should be added after "regard". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Jonsson et al [4,587,734], hereinafter Jonsson.

Jonsson discloses in Figs 1-4, a spoon-shaped implement comprised of a shallow bowl [blade 2] having an upper surface that is concave [Fig 1], an undersurface that is convex, and a leading edge; a handle 1 that is attached to the bowl at a location substantially opposite the bowl's leading edge, wherein the bowl has a plurality of grating holes [apertures 31 and scoops 32] through it that present a rubbing zone that is sufficiently rough that a gratable foodstuff can be reduced to small particles by rubbing it on the zone [col 3 line 39 to col 4 line 7] as recited in claim 1. Additionally, Jonsson discloses the rubbing zone is on the convex undersurface of the bowl [Fig 1] as recited in claim 2, the convex undersurface of the bowl generally defines a curvilinear plane and, as regards to at least some of the grating holes, the hole's opening on the convex undersurface of the bowl has a scooping edge 33 that protrudes above that plane and substantially faces away from the bowl's leading edge [Fig 1] as recited in claim 3.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolton [1,781,973].

Bolton discloses in Figs 1-7, a spoon-shaped implement comprised of a shallow bowl having an upper surface that is concave, an undersurface that is convex [Fig 5], and a leading edge; a handle that is attached to the bowl at a location substantially opposite the bowl's leading edge [Fig 1], wherein the bowl has a plurality of grating holes [h] through it that present a rubbing zone that is sufficiently rough that a gratable foodstuff can be reduced to small particles by rubbing it on the zone [col 1 first paragraph] as recited in claim 1. Additionally, Bolton discloses the rubbing zone is on the convex undersurface of the bowl [Fig 5] as recited in claim 2 and the convex undersurface of the bowl generally defines a curvilinear plane and, as regards to at least some of the grating holes, the hole's opening on the convex undersurface of the bowl has a scooping edge [P] that protrudes above that plane and substantially faces away from the bowl's leading edge [Fig 5] as recited in claim 3.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolton.

Bolton discloses most of the elements of this claim but for a majority of the grating holes have a scooping edge that spans a distance of about 2 to 5 millimeters.

Applicant has not disclosed that having scooping edge that spans a distance of about 2 to 5 millimeters solves any stated problem or is for any particular purpose [see specification pages 5 and 6]

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Bolton such that the scooping edge that spans a distance of about 2 to 5 millimeters because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Bolton.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson.

Jonsson discloses most of the elements of this claim but for a majority of the grating holes have a scooping edge that spans a distance of about 2 to 5 millimeters. Applicant has not disclosed that having scooping edge that spans a distance of about 2 to 5 millimeters solves any stated problem or is for any particular purpose [see specification pages 5 and 6]

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified Jonsson such that the scooping edge that spans a distance of about 2 to 5 millimeters because such a modification would have been considered a mere design consideration which fails to patentably distinguish over Jonsson.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 571-272-4423. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



Faye Francis